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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91195535
Party	Defendant National Information Solutions Cooperative, Inc.ve, Inc.
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Attachments	Answer to Notice of Opposition.pdf (6 pages)(18260 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Smartrac IP B.V.,)	
)	
Opposer,)	Opposition No. 91195535
)	
v.)	Mark: SMARTTRACK
)	
National Information Solutions Cooperative, Inc.,)	Serial No. 77932557
)	
Applicant.)	

ANSWER TO NOTICE OF OPPOSITION

The following is the Answer of Applicant National Information Solutions Cooperative, Inc. (“NISC”), owner of Federal Trademark Application Serial No. 77932557, for the mark SMARTTRACK (hereinafter “Applicant’s standard character mark”), by and through counsel, Wallace R. Goulet, Jr., to the Notice of Opposition filed July 2, 2010 by Smartrac IP B.V. (hereinafter “Opposer”), and assigned Opposition No. 91195535.

Applicant hereby responds, solely for the purpose of this proceeding, to each of the grounds set forth in the Notice of Opposition, as follows:

1. Applicant does not have sufficient information to admit or deny the allegations in Paragraph 1 and, therefore, denies the same.
2. The allegations of Paragraph 2 are admitted.
3. Applicant does not have sufficient information to admit or deny the allegations in Paragraph 3 and, therefore, denies the same.
4. Applicant admits Paragraph 4 in part and denies Paragraph 4 in part. Applicant admits that Smartrac IP B.V. is shown as the owner of Reg. No. 3302678 in the records of the U.S. Patent and Trademark Office, the content of which speaks for itself. Applicant does not

have sufficient information to admit or deny the remaining allegations of Paragraph 4 and, therefore, denies the same.

5. The allegations of Paragraph 5 are admitted.

6. Applicant does not have sufficient information to admit or deny the allegations in Paragraph 6 and, therefore, denies the same.

7. The allegations of Paragraph 7 either contain conclusions of law or fact to be determined in this proceeding or contain statements as to which Applicant does not have sufficient information to admit or deny, and therefore Applicant denies the same.

8. The allegations of Paragraph 8 either contain conclusions of law or fact to be determined in this proceeding or contain statements as to which Applicant does not have sufficient information to admit or deny, and therefore Applicant denies the same.

9. The allegations of Paragraph 9 either contain conclusions of law or fact to be determined in this proceeding or contain statements as to which Applicant does not have sufficient information to admit or deny, and therefore Applicant denies the same.

10. The allegations of Paragraph 10 are admitted.

FURTHERMORE, in answer to the Notice of Opposition, Applicant affirmatively asserts as follows:

11. Opposer's rights in its mark are of a narrow or limited scope because the mark is weak and because of numerous third party uses of similar marks. By way of example, Registration Number 2843683 for SMARTRAC was registered May 18, 2004 with a filing date of September 25, 2002 and a publication date of April 22, 2003; Registration Number 2233277 for SMARTRAC was registered March 23, 1999 with a filing date of February 27, 1997 and a publication date of December 29, 1998; and, Registration Number 1921783 for SMARTRAC was registered September 26, 1995 with a filing date of October 11, 1994 and a publication date

of July 4, 1995. The foregoing marks represent only three of the many marks similar to that registered to Opposer.

12. Opposer is estopped or otherwise precluded from claiming broad rights in its mark based on its own representation to the United States Patent and Trademark Office in its Response to Office Action, Serial Number 79015010, dated April 17, 2006, that “The number of cited registrations of SMARTRAC marks with the same or different spellings shows that the protection for each SMARTRAC mark is narrow... If a new application for SMARTRAC has different goods then it should be allowed.”

13. The goods represented by Applicant’s proposed mark are different from those offered by Opposer. Opposer claims it is a developer, manufacturer, and supplier of radio frequency identification (RFID) components for a broad bandwidth of applications in all current frequency standards. Opposer produces ready-made as well as customized transponders for public transport, access control, RFID-based car immobilizers, animal identification, libraries, industry, and logistics. Opposer’s products include core elements of RFID systems for contactless data transmission.

14. Applicant’s proposed mark will be used in connection with computer software for graphical resource management. Applicant’s product does not utilize radio frequency identification technology; indeed, Applicant’s product is not used for identification purposes.

15. Opposer is estopped or otherwise precluded from claiming broad rights in its mark based on its representation to the United States Patent and Trademark Office in its Response to Office Action, Serial Number 79015010, dated October 25, 2006 that there

are many smart track registrations in class 9 which are aurally equivalent. Therefore, the scope of protection is narrow for each registration... Since, the scope of protection is narrow for each registration cited, and the goods of the [other SMARTRAC] Registrant’s and the goods of the [Opposer] are very different, it is further amplified that there would be no likelihood of confusion.

16. Opposer is estopped or otherwise precluded from claiming likelihood of confusion between Applicant's mark/product and Opposer's mark/product because, according to Opposer in its Response to Office Action, Serial Number 79015010, filed with the United States Patent and Trademark Office and dated October 25, 2006:

[Opposer's] goods are of a very high and specialized technology. They are not bought by impulse purchasers. Their sales will be the result of a sophisticated sales effort. The consumers are sophisticated purchasers who take care in making purchasing decisions and will not be confused by similar marks. The goods of the [Opposer] are also unique... For these reasons the possibility of confusion is unlikely.

17. Opposer has waived any claim of broad rights in its mark based upon its failure to file any notice of opposition with respect to the following registered marks: SMARTTRACK, Registration Number 3112974 with a registration date of July 4, 2006 and a publication date of September 27, 2005; SMARTTRACK, Registration Number 3811591 with a registration date of June 29, 2010 and a publication date of August 4, 2009; and, SMARTTRACK, Registration Number 3017319, with a registration date of January 24, 2006 and a publication date of November 1, 2005.

18. Applicant's use of its mark will not mistakenly be thought by the public to derive from the same source as Opposer's goods; nor will such use be thought by the public to be a use by Opposer or with Opposer's authorization or approval.

19. Applicant's mark in its entirety is sufficiently and distinctively different from Opposer's mark so as to avoid confusion, deception, or mistake as to the source or sponsorship or association of Applicant's goods.

WHEREFORE, Applicant respectfully requests that this opposition proceeding be dismissed, with prejudice.

Dated: July 29, 2010

Respectfully submitted,

/Wallace R. Goulet, Jr./

Wallace R. Goulet, Jr.

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As Counsel for Applicant/Defendant

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the Answer to Notice of Opposition was served this 29th day of July, 2010 by mailing to the attorneys of record for Opposer, Dean R. Karau and Cynthia A. Moyer, Fredrikson & Byron, P.A., 200 South Sixth Street, Suite 4000, Minneapolis, Minnesota 55402-1425, which is the last known address of each addressee, by depositing said document in the United States mail at Mandan, North Dakota.

/Wallace R. Goulet, Jr./
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